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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,534

Applicant(s)

SIEGEL ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Specification Objection

The disclosure is objected to because of omission of the following:

(a) Background of the Invention

1. Field of the Invention

2. Description of the Related Art including information disclosed under 37 CFR

1.97 and 1.98.

Appropriate correction is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites "The system of claim 11." There is insufficient antecedent basis for claim 13 because claim 11 has been cancelled.

Claim 14 recites "The system of claim 11." There is insufficient antecedent basis for claim 14 because claim 11 has been cancelled.

Claim 17 recites "the data is maintained by a seller." There is insufficient antecedent basis for "the data."

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Claim Rejections - 35 USC § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 101 that form the basis for the rejections under this section made in this Office Action:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The MPEP § 2106, Section ii) Computer-Related Processes Limited to a Practical Application in the Technological Arts states:

There is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory nor determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Consider claim 1 in light of the above.

1. The preamble reads of instant invention reads “A method of providing product information comprising.” A computer-related process is not claimed in the preamble nor in the method steps of claims 1-3 and 9. Claim 1 claims storing a first/second characteristic but that is not directly related to a computer-related process because there are many means of storing a characteristic value. Examiner maintains that Applicant should claim computer readable code stored on computer readable medium so that instant invention can be considered a practical application in the technological arts.

Claims 1-9, 12 and 15–18 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility for the reasons given below.

Consider MPEP § 2106, which states:

When nonfunctional descriptive material is recorded on some computer readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 13333, 200 USPAQ 132, 137 (CCPA 1978).

Claims 1, 6, 12 and 15 include “changing at least one of the characteristic values.” Claim 6 includes similar language. The method of changing the characteristic value is not claimed nor supported in the specification. The term “changing” is overly broad. Every possible means of changing the “characteristic value” is, therefore, inherently included in Applicant’s overly broad claim language. In particular, a computer glitch, as is often caused by a brief power surge, could change the characteristic value. Such a change, obviously would not comply with the requisite functionality of 35 U.S.C. 101.

Assume, for sake of argument, that the characteristic value was in fact manually performed or even automatically generated by a computer program. Claims 1, 6, 12 and 15 still lack functionality for it is unclear why the change was made. A change lacking a stated purpose cannot be described as functional, i.e., useful and/or practical. In fact, it can be argued, that the change was made in isolation, and is thus nonfunctional.

The claimed “changing at least one of the characteristic values” cannot even be described as manipulation of an abstract idea since Applicant fails to claim what the underlying abstract idea might be. Therefore, “changing at least one of the characteristic values” constitutes manipulation of a data structure. Such manipulation of a data structure does not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permits the data’s functionality to be realized.

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Claims 2-5, 7-9, 13, 14, and 16-18 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9, 12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No. 5,913,210 issued to Call (hereafter Call '210).

Claim 1:

Call '210 discloses:

- associating a first code [universal product code and first Internet address per col 3, lines 48-60] with a first characteristic of a product and a second code [universal product code and second Internet address per col 3, lines 48-60] with a second characteristic of the same product,
- storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [registration handler, Fig 2, item 203]
- associating the identity of a first entity with at least one of the codes [col 3, lines 48-60],
- changing at least one of the characteristic values [col 4, lines 34-37, col 6, lines 22-30, col 8, lines 32-42],
- retrieving the identity of the first entity based on the association with the code associated with the characteristic with the changed value [col 6, lines 31-42]

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- sending the changed value to the first entity [col 3, lines 48-55, col 8, lines 32-42, col 6, lines 31-42]

Claim 3:

Call '210 discloses wherein associating the identity of a first entity with at least one of the codes includes setting an update value, the update value indicating whether the first entity automatically receives changes to the characteristic associated with the code, and wherein retrieving the identity of the first entity includes determining the update value [col 9, lines 20-35].

Claim 4:

Call '210 discloses sending the change by email [col 4, lines 44-52 and col 7, lines 7-10]

Claim 5:

Call '210 discloses retrieving the electronic address of the first entity [col 4, lines 10-26]

Claim 6:

Call '210 discloses:

- providing product data associating information codes to information about a product [col 3, lines 48-60],
- providing destination data correlating the information codes to entities [col 4, lines 10-26],
- modifying the information about the product [col 4, lines 34-37, col 8, lines 32-42]
- identifying a first entity based upon the information code associated with the information about the product, the product data and the destination data [col 3, lines 48-60]
- transmitting the modified information about the product to the first entity [col 3, lines 48-55 and col 8, lines 32-42]

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Claim 7:

Call '210 discloses wherein the modified information is transmitted over a network and the first entity is a computer on the network [Fig 1, items 120 and 103]

Claim 8:

Call '210 discloses wherein the network is the Internet [col 2, lines 28-33]

Claim 9:

Call '210 discloses wherein the product is a service [col 2, lines 33-47]

Claim 12:

Call '210 discloses:

- means for associating a first code [first Internet address per col 3, lines 48-60] with a first characteristic of a product and a second code [second Internet address per col 3, lines 48-60] with a second characteristic of the same product,
- means for storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [Fig 2, item 203]
- means for associating the identity of a first entity with at least one of the codes [col 3, lines 48-60],
means for changing at least one of the characteristic values [col 4, lines 34-37 and col 8, lines 32-42]

Claim 15:

Call '210 discloses:

- a processor [Fig 1, item 103]
- data instructions [Fig 1, item 103] executable by the processor, the instructions including:

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- associating a first code with a first characteristic of a product and a second code [second Internet address per col 3, lines 48-60] with a second characteristic of the same product [first Internet address per col 3, lines 48-60];
- storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [Fig 2, item 203]
- associating the identity of a first entity with at least one of the codes [col 3, lines 48-60];
- changing at least one of the characteristic values [col 4, lines 34-37, col 8, lines 32-42];
- retrieving the identity of the first entity based on the association with the code associated with the characteristic with the changed value [col 6, lines 31-42];
- sending the changed value to the first entity [col 6, lines 31-42]

Claim 16:

Call '210 discloses wherein the system comprises a server connected to a network and the first entity comprises another server on the network [col 3, line 60 through col 4, line 10]

Claim 17:

Call '210 discloses wherein the system comprises a server connected to a network, the data is maintained by a seller, and the first entity is a buyer of the product from the seller [Fig 1 and abstract].

Claim 18:

Call '210 discloses wherein the product is a service [col 2, lines 33-47]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,913,210 issued to Call (hereafter Call '210).

Claim 2:

Call '210 discloses the elements of claim 1 as noted above.

Call '210 fails to disclose associating the identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity.

However, Call '210 discloses the product codes and the Internet addresses are provided by or on behalf of participating manufacturers and suppliers [col 2, lines 50-52].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Call '210 to include associating the identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity.

The ordinarily skilled artisan would have been motivated to modify Call '210 per the above for the purpose of controlling the scope and content which a manufacturer makes available [col 8, lines 32-35].

Response to Arguments

Applicant's arguments filed 11/3/03, have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant states in the paragraph linking pages 11 and 12, "In contrast, claims 1 and 15 recite 'associating the identity of a first entity with at least one of the codes, changing at least one of the characteristic values, retrieving the identity of the first entity based on the association with the code associated with the characteristic with changed value and sending the changed value to the first entity.' In this regard, claims 1 and 15 are not disclosed or suggested by Call because in Call the characteristic values of a product are stored at a manufacturer's web site or server and therefore, in accordance with claims 1 and 15, the manufacturer would necessarily have to send the changed value to a first entity, which, based on Call, would have to be the product code translator. However, the product code translator of Call is not taught as housing characteristic values relating to products. In fact, the only product information retained by Call's product code translator is product codes (see Fig 2). In addition, Call does not suggest placing characteristic values information on the product code translator. Thus Call does not teach sending a characteristic value to the product code translator. It follows therefore that Call does not anticipate claims 1 and 15.

First Examiner Response:

Examiner is not persuaded. Supra office Action rejects "changing at least one of the characteristic values" in terms of the following disclosure by Call in column 2, lines 33-48:

The present invention enables the retrieval of information about products from the source of those products, typically the manufacturer, by those who need that information, such as resellers and consumers. In accordance with the invention, any person or firm having access to the

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Internet and knowing the universal product code for a product may obtain information about that product from the participating manufacturer which supplies that product. The system employs a product code translator, which may be implemented by a plurality of servers but which is illustrated by the single resource seen at 101 in FIG. 1. The product code translator is accessed via the Internet to perform a **translation of specified universal product codes into the corresponding Internet addresses from which information about the designated products can be obtained.**

Furthermore, Call discloses in column 6 lines 20-30 the following:

Note that it is further unnecessary for the manufacturer to have, or supply, an assigned URL rather than a numerical IP address; however, since corresponding URL's are ordinarily available and easier to remember, and because it may be desirable to later change numerical IP addresses while retaining the same URL, the use of URL's for registration is preferred. **Note also that, because URL/IP address assignments may be added, altered or deleted on a daily basis** by InterNIC (the URL assignment authority), updates to the DNS tables should also be reflected by automatic updates to the cross-reference table IP-Address fields. In this way, a change in URL/IP address assignments propagated in the DNS system require no additional action on behalf of the manufacturers to insure the continuing ability of the product code translator to produce the appropriate new IP addresses in response to universal product code queries.

Based on the above disclosure by Call, examiner maintains reads on "changing at least one of the characteristic values"

Second Applicant Argument:

Applicant states on page 12 "Moreover, in accordance with claims 1 and 15, the changed value is sent to the first entity. The only other interpretation of Call in view of the claims is that the first entity is the manufacturer, which, in accordance with Call, would necessarily result in the manufacturer sending the changed characteristic value to itself. Applicants respectfully submit that this leads to both an illogical interpretation of what's disclosed in Call and does not reflect what is claimed.

Second Examiner Response:

Examiner is not persuaded. Call discloses the following in column 3, lines 48 through 58:

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The product code translator seen at 101 in FIG. 1 performs two primary functions illustrated in FIG. 2: (1) its registration handler 203 accepts cross-references submitted by manufacturers which relate their assigned universal product codes to associated Internet addresses where information relating to their products may be obtained, and (2) its query handler 204 accepts queries via the Internet 205, each query including all or part of one or more universal product codes and returns the Internet addresses which can be used to obtain information about the products identified by those codes.

Call teaches that the manufacturer is responsible for assigning universal product codes and

Internet addresses where information about their products may be obtained. It is the manufacturer that provides product information to the product code translator [Fig 1, item 101].

In this instance, therefore, the first entity is the product code translator. Examiner concludes that above disclosure by Call reads on the claimed "sending the changed value to the first entity."

Third Applicant Argument:

Applicant states in the paragraph linking pages 12 and 13 "To be clear, nowhere in Call is it disclosed that the identity of a manufacturer or first entity is retrieved based on a code associated with a characteristic value of a product, because the entity in Call from which identity information is retrieved, i.e., the product code translator, does not store any product information other than a universal product code (which is not a characteristic value of a product) and the addresses of manufacturers. Thus, the product code translator cannot identify a manufacturer based on information that is clearly does not have access to, i.e., a characteristic value of a product.

Third Examiner Response:

Examiner is not persuaded. Applicant states in the paragraph linking pages 12 and 13 that Call does not teach the limitations claims 1 and 15. Examiner is perplexed as Call's disclosure relevant to claims 1 and 15 is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and

specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Fourth Applicant Argument:

Applicant states on page 13 "For the same reasons discussed above, Call also does not anticipate claim 6, which recites 'modifying the information about the product, identifying a first entity based upon the information code associated with the information about the product, the product data and the destination data, and transmitting the modified information about the product to the first entity.'"

Fourth Examiner Response:

Examiner is not persuaded. Applicant states on page 13 that Call does not teach the limitations of claim 6. Examiner is perplexed as Call's disclosure relevant to claim 6 is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Fifth Applicant Argument:

Applicant states on page 13 "In addition, because claim 12 recites 'means for associating the identity of a first entity with at least one of the codes, means for changing at least one of the characteristic values, means for retrieving the identity of the first vendor based on the association with the code associated with the characteristic with the changed value, and means for sending the changed value to the first vendor' claim 12 is also not anticipated by Call for the same reasons."

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Fifth Examiner Response:

Examiner is not persuaded. Applicant states on page 13 that Call does not teach the limitations of claim 12. Examiner is perplexed as Call's disclosure relevant to claim 12, is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

12/8/2003 


SAFET METJAHIC
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